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OFFICE OF PETITIONS

In re Patent No. 7,155,744 :
Daniel Schreiber and :
Andrew Goldman : DECISION DISMISSING PETITION
Issue Date: December 26, 2006 : UNDER 37 CFR 1.55(c)
Application No. 09/730,326 : and
Filed: December 4, 2000 : ON REQUEST FOR CERTIFICATE
Title: COPYRIGHT PROTECTION OF : OF CORRECTION
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This is a decision on the PETITION TO ACCEPT UNINTENTIONALLY DELAYED CLAIM OF PRIORITY UNDER 37 C.F.R. 1.55(c) AND REQUEST FOR CERTIFICATE OF CORRECTION, filed August 25, 2011, to add benefit claims to Israeli Patent Application Nos. 124895 filed June 14, 1998, 127093 filed November 16, 1998 and 127869 filed December 30, 1998, by way of issuance of a certificate of correction.

As stated in MPEP 201.16,

A certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 may be requested and issued in order to perfect a claim for foreign priority benefit in a patented continuing application if the requirements of 35 U.S.C. 119(a)-(d) or (f) had been satisfied in the parent application prior to issuance of the patent and the requirements of 37 CFR 1.55(a) are met. Furthermore, if the continuing application (other than a design application), which issued as a patent, was filed on or after November 29, 2000, in addition to the filing of a certificate of correction request, patentee must also file a petition for

an unintentionally delayed foreign priority claim under 37 CFR 1.55(c)¹.

Patentee states that with respect to IL 127093 and 127869 the requirements of 35 U.S.C. 119(a)-(d) were satisfied in parent application No. 09/397,331 (now U.S. Patent No. 6,298,446) prior to issuance of the patent. Patentee states that with respect to IL 124895 the requirements of 35 U.S.C. 119(a)-(d) were satisfied in parent application No. 09/313,067 (now U.S. Patent No. 6,209,103) prior to issuance of the patent. This application is a continuing application of the '331 and '067 applications. A review of the '103 patent confirms that it issued on March 27, 2001 with the foreign priority benefit thereon. By certificate of correction signed September 27, 2011, the '446 patent was corrected to include the foreign priority benefit thereon to all three Israeli applications.

Accompanying the petition to accept the delayed claim of priority is a certificate of correction setting forth the requested foreign priority claim and payment of the certificate of correction processing fee.

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date, and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6));
- (3) the surcharge as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional (the Director may require

¹ However, a claim to foreign priority benefits cannot be perfected via a certificate of correction if the requirements of 35 U.S.C. 119(a)-(d) or (f) had not been satisfied in the patented application, or its parent, prior to issuance and the requirements of 37 CFR 1.55(a) are not met. In this latter circumstance, the claim to foreign priority benefits can be perfected only by way of a reissue application in accordance with the rationale set forth in Brenner v. State of Israel, 158 USPQ 584.

additional information where there is a question whether the delay was unintentional); and
(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

This application filed December 4, 2000, was filed after November 29, 2000. The petition includes a claim for priority to foreign application/patent No. IL 124895, filed June 14, 1998; 127093 filed November 16, 1998; and 127869 filed December 30, 1998. Moreover, the petition includes payment of the surcharge and a proper statement of unintentional delay. Intermediate application No. 09/313,067 filed May 17, 1999 was filed within 12 months of the filing date of all 3 foreign applications.

However, requirement (2) above is not met. Israeli application Nos. 127093 and 127869 are referred to in the declaration submitted on filing; however, no box is present or checked to claim priority. With respect to Israeli application No. 124895, the claim is not included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6)).

In view thereof, the petition under 37 CFR 1.55(c) is DISMISSED.

Any renewed petition must satisfy requirement (2) above.

The correspondence address of record remains with Perkins & Coie. A courtesy copy of the decision is being mailed to the address on the petition. All future correspondence will be sent to the address of record until such time as a proper change of correspondence address is filed.

Any inquiries directly pertaining to this matter may be directed to the undersigned at (571) 272-3219.



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